Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANVIR S. VIRDI

Appeal No. 1997-3644
Application No. 08/442,633

ON BRIEF

Before JOHN D. SMITH, LIEBERMAN, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11-20, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a rubber vulcanization process. According to appellant, nitrosamines production is minimized in such a process via the use of an accelerating or vulcanizing effective amount of a compound having a group of

formula R_2NCS- or R_2NS-, wherein both R groups are identical C_9H_{19} branched alkyl. Claim 11, the sole independent claim on appeal, is reproduced below.

11. A method for minimizing the production of nitrosamines in the vulcanisation of rubber, the improvement comprising incorporating an accelerating or vulcanising effective amount of a compound including a group of the formula R_2NCS- or R_2NS-, wherein the two R groups are identical C_9H_{19} branched alkyl.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Amidon et al. (Amidon) 3,674,824 July 04, 1972
Mastromatteo et al. (Mastromatteo) 3,678,135 July 18, 1972

Claims 11-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Amidon or, in a separately stated § 103 rejection, over Mastromatteo.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. In so doing, we find ourselves in agreement with

appellant's position on the basis that the examiner fails to establish a

prima facie case of obviousness[1] for the claimed subject matter. Accordingly, we will not sustain the examiner's stated rejections.

The examiner appears to rely on each of Amidon and Mastromatteo for describing classes of acceleration compounds for use in rubber vulcanization that are generic to the limited subgenus/species of appellant. However, the examiner has not adequately explained how one of ordinary skill in the art would have been led to select an acceleration compound corresponding to or within the limited class of compounds as herein claimed from the teachings of the separately applied references.

We do not share the examiner's viewpoint regarding the apparently applied *per se* rule of obviousness that "choosing compounds from a generic description would be obvious..." (answer, page 4). As stated by the Federal Circuit in

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[1] We note that it is the examiner who bears the initial burden of presenting a *prima facie* case of obviousness in rejecting claims under 35 U.S.C. § 103. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." Moreover, the mere possibility that the prior art could be modified such that appellant's process is carried out is not a sufficient basis for a *prima facie* case of obviousness. *See In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Also, *see* § 2144.08 of the *Manual of Patent Examining Procedure* (MPEP)(7th ed., Feb. 2000).

For the foregoing reasons, we find that the examiner has not established a *prima facie* case of obviousness. Because we reverse on this basis, we need not reach the issue of the sufficiency of the asserted secondary evidence (brief, pages 10-12). *See In re Geiger,* 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

CONCLUSION

The decision of the examiner is reversed.

REVERSED

JOHN SMITH)

Administrative Patent Judge	)
	)
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	) BOARD OF PATENT
PAUL LIEBERMAN	) APPEALS
Administrative Patent Judge	) AND
	) INTERFERENCES
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	)
PETER F. KRATZ	)
Administrative Patent Judge	)

PFK/kis

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